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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,574	09/21/2001	Edward Panelli	GEMS:0112/YOD 15-EC-5739	1965
7590 03/31/2006 Patrick S. Yoder Suite 330 7915 FM 1960 West Houston, TX 77070			EXAMINER HAQ, NAEEM U	
			ART UNIT 3625	PAPER NUMBER
DATE MAILED: 03/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/682,574

Applicant(s)

PANELLI ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-16, 19-24 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 19-24 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' amendment filed January 18, 2006. Claims 10, 17, 18, 25-29, and 38-54 have been cancelled. Claims 1-9, 11-16, 19-24, and 30-37 are pending and will be considered for examination.

Applicants' amendment is sufficient to overcome the objection to claims 35 and 36. The claim objection is hereby withdrawn.

### ***Final Rejection***

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-9, 11, 14-16, 19-24, 30-33, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Wallman (US 6,338,047 B1).**

Referring to claim 1: Wallman discloses an electronic information system (Figure 1), wherein the electronic information system is accessible electronically via an electronic communication system (col. 8, lines 31-33: "...users 110 access the computer-based system...through an interface 120"), wherein the electronic information system is operable to enable a customer to access the electronic information system via the electronic communication system to create a standing order electronically for periodic delivery of a product, good, or service (col. 8, lines 31-41; col. 9, lines 19-27, lines 49-62; col. 10, lines 34-45: "...investor issues a standing order..."). Moreover, the Examiner notes that claim 1 is directed to a system, and therefore the claimed invention should be distinguishable from the prior on the basis of structural elements rather than intended function. MPEP 2114 states the following:

*"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)... A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all*

*the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer"*

Claim 1 recites the limitations "...of a customer specified duration..." and "...to a specified customer location..." The Examiner notes that the Wallman reference discloses all the claimed structural elements of claim 1. Therefore, as per MPEP 2114 guidelines, Wallman reads on the claimed system. Furthermore, the system of Wallman is capable of performing the intended function of enabling a customer to specify a duration and location.

Referring to claim 2: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic communication system comprises the Internet (col. 8, lines 31-35: "The interface 120 includes a variety of communications systems, such as the Internet 121...").

Referring to claim 3: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and identify electronically the product, good, or service to be delivered periodically under the standing order (col. 8, lines 31-41; col. 9, lines 19-27, lines 49-62; col. 10, lines 34-45).

Referring to claim 4: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system to select the product, good, or service to be delivered periodically under the standing order from a selection of products, goods, or services provided by a supplier (col. 9, lines 6-22; col. 10, lines 34-45).

Referring to claim 5: Wallman discloses all the limitations of claim 4 as noted above. Furthermore, Wallman discloses that the electronic information system enables the customer to access the electronic information system via the electronic communication system to revise the product, good, or service to be delivered periodically under the standing order (col. 10, lines 34-45: "Of course the standing order can be modified at any time...").

Referring to claim 6: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and order a desired quantity of the product, good, or service to be delivered periodically under the standing order (col. 10, lines 34-45: "...funds are invested according to a standing allocation order that the investor issues.")

Referring to claim 7: Wallman discloses all the limitations of claim 6 as noted above. Furthermore, Wallman discloses that the electronic information system enables the customer to access the electronic information system via the electronic communication system and revise the desired quantity of the product, good, or service

to be delivered periodically under the standing order (col. 10, lines 34-45: "Of course the standing order can be modified at any time...").

Referring to claim 8: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic information system is operable to enable the customer to access the electronic information system via the electronic communication system and establish a desired frequency of delivery of the product, good, or service to be delivered periodically under the standing order (col. 10, lines 34-45: "...an investor issues a standing order that funds are to be transferred automatically from a personal account into the fund on a substantially regular...basis.")

Referring to claim 9: Wallman discloses all the limitations of claim 8 as noted above. Furthermore, Wallman discloses that the electronic information system enables the customer to access the electronic information system via the electronic communication system to revise the desired frequency of delivery of the product, good, or service to be delivered periodically under the standing order (col. 9, lines 55-58: "...batches of transactions are done once a day or more or less frequently, at the system's operator's discretion...or as agreed with users."; col. 10, lines 40-41: "Of course the standing order can be modified at any time...").

Referring to claim 11: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, the limitation of "at least one processor electrically coupled to the electronic communication system; and a computer program stored in memory, wherein the computer program and processor are operable to enable the electronic information system to communicate electronically with the customer to create the standing order" is

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inherent in the invention of Wallman because Wallman discloses a computer-based system that electronically communicates with the user.

Referring to claim 14: Wallman discloses all the limitations of claim 1 as noted above. Moreover, the Examiner notes that claim 14 is directed to a system, and therefore the claimed invention should be distinguishable from the prior on the basis of structural elements rather than intended function. MPEP 2114 states the following:

*"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)... A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer"*

Claim 14 recites the limitation "...wherein the electronic information system is operable to enable the customer to access the electronic information system via the electronic



communication system to review a standing order for periodic delivery of a product, good, or service.” The Examiner notes that the Wallman reference discloses all the claimed structural elements as noted in claim 1. Therefore, as per MPEP 2114 guidelines, Wallman reads on the system claimed in claim 14. Further, the system of Wallman is capable of performing the intended function of enabling a customer to review a standing order.

Referring to claim 15: Claim 15 is rejected under the same rationale as set forth above in claim 14. The system of Wallman is capable of performing the intended function of enabling a supplier to direct the periodic delivery of the product, good, or service.

Referring to claim 16: Wallman discloses all the limitations of claim 1 as noted above. Furthermore, Wallman discloses that the electronic information system incorporates business rules provided by a supplier for the creation of a standing order, wherein the electronic information system prevents the customer from creating a standing order in violation of the business rules (col. 6, lines 32-46; Figure 3, items “350”).

Referring to claims 19 and 30: Claims 19 and 30 are rejected under the same rationale as set forth above in claim 1.

Referring to claims 20, 32, and 33: Claims 20, 32, and 33 are rejected under the same rationale as set forth above in claim 8.

Referring to claim 21: Claim 21 is rejected under the same rationale as set forth above in claim 6.

Referring to claim 22: Claim 22 is rejected under the same rationale as set forth above in claim 14.

Referring to claims 23, 35, and 36: Claims 23, 35, and 36 are rejected under the same rationale as set forth above in claim 5.

Referring to claim 31: Claim 31 is rejected under the same rationale as set forth above in claim 2.

Referring to claims 24 and 37: Claims 24 and 37 are rejected under the same rationale as set forth above in claim 16.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12, 13, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (US 6,338,047 B1) in view of Official Notice.**

Referring to claim 12: Wallman discloses all the limitations of claim 11 as noted above. Wallman does not disclose that the electronic information system requires the customer to provide an authorization identifier before enabling the customer to create the standing order. However, Official Notice is taken that it is old and well known in the art to use a username and password as a form of authorization identifier. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was

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made, to incorporate a username and password (i.e. authorization identifier) in the invention of Wallman. One of ordinary skill in the art would have been motivated to do so in order to verify the identity of the user prior to allowing the user to transfer his or her funds.

Referring to claims 13 and 34: Wallman discloses all the limitations of claims 1 and 30 as noted above. Wallman also discloses that the electronic information system provides the customer accessing the electronic information system with an interface (col. 8, lines 31-33: "...users 110 access the computer-based system...through an interface 120"). Wallman does not teach that the interface is an interactive visual interface. However, Official Notice is taken that it is old and well known in the art to use an interactive visual interface such as a GUI. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a GUI in the invention of Wallman. One of ordinary skill in the art would have been motivated to do so in order to provide the user with a graphically enriched, user-friendly interface.

### ***Response to Arguments***

Applicants' arguments have been fully considered but they are not persuasive. The Applicants have argued that Wallman does not teach a user specified duration and location, and therefore Wallman fails to anticipate the claimed invention. The Examiner respectfully disagrees. As noted above and in the previous Office Action, the claimed features are merely an intended use of the claimed invention and do not patentably

distinguish the claimed invention from the prior art. For this reason, the Examiner maintains the art rejection.

The Examiner notes that the Applicants did not respond to the Examiner's use of Official Notice in the rejection of claims 12, 13, and 34. In order to adequately traverse a rejection based on common knowledge (i.e. Official Notice), an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice is inadequate. In the present case, the Applicants did not respond to the Examiner's rejection using Official Notice. Furthermore, the Applicants failed to argue why the noticed fact is not considered to be common knowledge or well-known in the art. Instead, the Applicants have provided a general allegation of patentability of claims 12, 13, and 34. For this reason, Applicants' response is considered to be an inadequate traversal of the Official Notice.

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.*

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pond can be reached on (571)-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

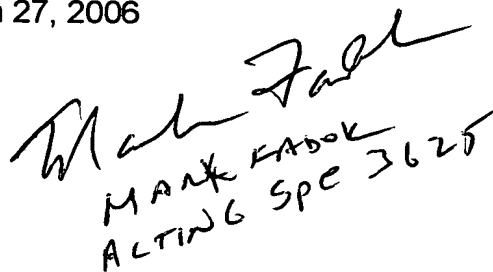
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

March 27, 2006



MARK KABOK  
ACTING SPE 3625